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APPLICATION NUMBER	FLING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/675,943	09/29/00	ESSWEIN	A 9486
		EXAMINER	
000151	HM12/0816	STOCK/ACCOUNT NO.	PAPER NUMBER
HOFFMANN-LA ROCHE INC. PATENT LAW DEPARTMENT 340 KINGSLAND STREET NUTLEY NJ 07110		1626	8
		DATE MAILED:	08/16/01

This is a communication from the examiner in charge of your application.  
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#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on August 1, 2001

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 7 and 21-24 are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) 7 and 21-24 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been:

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/675,943  
U.S. GPO: 1998-404-498/40517

## DETAILED ACTION

Claims 7 and 21-24 are pending in the application. Because of an error in the last Office Action, the following is required.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 7 and 21-23, drawn to products of formula (I) wherein **X is oxygen**, classified in class 558, subclass 182.

→ II. Claims 7, 23 and 24, drawn to products of formula (I) wherein **X is NH**, classified in class 558, subclass 170 and class 548.

The inventions are distinct, each from the other because of the following reasons: the products of Group I and Group II differ materially in structure and element so much so as to be patentably distinct. In

addition, a reference which anticipates one group may not even render obvious the other.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Further, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species that is embraced by whichever Group is elected, even though this requirement is traversed.

Applicants are required to provide an Example number, page number in the specification and a structural depiction of the elected species when responding to this Office Action.

Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is suggested that in order to advance prosecution, the non-elected subject matter be cancelled when responding to this Office Action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants state a notice to make drawing changes was included in the previous Office Action. In response, this matter will be addressed when a first action on the merits is provided by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.



Laura L. Stockton  
Laura L. Stockton  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

August 15, 2001